

Remarks

Claims 1-24 are pending in the above-identified application. The Examiner rejected claims 1-3, 5, 7-10, 12, 14, 15 under 35 U.S.C. § 102(e), and rejected claims 4, 6, 11, 13, 16-24 under 35 U.S.C. § 103(a). With this amendment Applicant has canceled, without prejudice, claims 8-24 and therefore the rejections of these claims need not be discussed. Claim 1 has been defined to more clearly define the invention. Claims 2-7 are dependent on claim 1.

Claim Rejections - 35 U.S.C. §102:

MPEP §2129 states:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,631,2 USPQ2d 1051,1053 (Fed. Cir.1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236,9 USPQ2d 1913,1920 (Fed. Cir.1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831,15 USPQ2d 1566 (Fed. Cir.1990).

The Examiner rejected claims 1-3, 5, 7-10, 12, 14, 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,195,558 to Griffith et al.

The Examiner alleged that the claimed invention reads on Griffith et al. as follows:

"Griffith et al. discloses a method, comprising the steps of assigning a first number to a mobile station that upon location of the mobile station at a first location allows connection to the mobile station of a call that employs the first number (col. 2 lines 54-58 and col. 3 lines 1-35); and assigning a second number to the mobile station that upon location of the mobile station at a second location allows connection to the mobile station of a call that employs the second number (col. 3 lines 1-35), wherein the second number (538-1902) differs from the first number (538-1901) , wherein the second location differs from the first location (location 103 and location 104) (col. 3 lines 1-35)."

In the September 23 office action the Examiner agreed with Applicant's statement that Griffith et al. teach that when a wireless terminal enters a new location, the telephone number assigned to the wireless terminal is automatically changed to be a telephone number assigned to that location. However, the Examiner stated that he only addressed what was disclosed in the claims. The Examiner explained that, for example, claim 1, recites a method comprising the steps of: assigning a first number to a mobile station that upon location of the mobile station at a first location allows connection to the mobile station of a call that employs the first number; and assigning a second number to the mobile station that upon location of the mobile station at a second location allows connection to the mobile station of a call that employs the second number, wherein the second number differs from the first number, wherein the second location differs from the first location. However, even though the telephone number changes when the mobile unit moves into different location, the mobile station is still assigned a telephone number for that location. The Examiner reads the limitation "assigning a first number to a mobile station that upon location of the mobile station at a first location allows connection to the mobile station of a call." Griffith et al. teaches this in (col. 2 lines 53-58 and col. 3 lines 10-17) based upon the mobile location which moves into location 103 or 104, it is assigned a telephone number for that location

(col. 2 lines 53-58 and col. 3 lines 10-17). According to the Examiner, It does not make a difference if the telephone number changes base upon mobile station location, the claim reads "assigning a first number to a mobile station that upon location of the mobile station at a first location allows connection to the mobile station of a call" which Griffith et al. teaches.

Applicant wishes to thank the Examiner for pointing this out and in response thereto Applicant has amended the claims.

As previously set forth, in the specification of the present application, on page 1, a prior art system is described that employs a normal business telephone number to reach a mobile station of a mobile subscriber in all user zones and public areas. For example, a caller dials the normal business number to reach the mobile station in a business user zone, a home user zone, one or more temporary user zones, and one or more public areas.

As one shortcoming, such a system allows any caller that knows the normal business number of the mobile station to reach the mobile subscriber in all locations. In one example, the mobile subscriber desires to receive calls from only a select group of potential callers when the mobile subscriber is located in a temporary user zone that comprises a conference location or a vacation location. Nevertheless, such a system undesirably allows all callers that know the normal business number of the mobile station to reach the mobile subscriber even in the temporary user zone.

Thus, a need exists in the prior art for increased selectivity in allowing connection of calls to a mobile station at a particular location. The present invention fulfills this need by providing a system and method wherein, referring to FIG. 1, in one example, user 106 comprises a subscriber, controller 104 comprises a service provider, mobile station 112 comprises a phone, number 136 comprises 630-979-1111, and number 138 comprises 630-979-2222. For example, when the subscriber purchases the phone, the service provider

assigns the numbers 630-979-1111 and 630-979-2222 to the phone of the subscriber, and the service provider defines one or more instances of user zone 121.

Still referring to FIG. 1, the number 630-979-1111 can be used to locate the subscriber all across a country, for example, the United States. The service provider can assign user zones (e.g., a plurality of instances of user zone 121) to the subscriber, and on a permanent basis add these user zones to a subscriber database of the service provider. If the subscriber is located in any of the user zones, then the subscriber can benefit from a specific billing rate and a set of features assigned to that user zone.

Further referring to FIG. 1, the service provider can define temporary user zones (e.g., a plurality of instances of temporary user zone 125) across the country for the purpose of conferences, vacations, and/or the like. For a specific subscriber, these temporary user zones in one example are assigned to the subscriber database of the service provider on a temporary basis. For example, the temporary user zones are not assigned to the subscriber database on a permanent basis for the specific subscriber. Upon request from the subscriber in areas in which these temporary user zones are available, the subscriber can take advantage of a temporary user zone on a temporary basis.

Again referring to FIG. 1, the number 630-979-2222 in one example can be assigned to the subscriber for use only within the temporary user zones. As a result, the subscriber can only be reached via 630-979-2222 within the scope of these temporary user zones. This provides them with privacy in receiving only selected calls while they are staying in the temporary user zones.

Referring still to FIG. 1, the number 630-979-1111 in one example can be used to reach the subscriber all over the country, except in the temporary user zones. Only the number 630-979-2222 can be used to reach the subscriber within the temporary user zones. If one tries to reach the subscriber located in a temporary user zone via 630-979-1111, then

the call will be forwarded to voice mail 144 for the subscriber. In addition, if one tries to reach the subscriber via 630-979-2222 when the subscriber is outside a temporary user zone, then the call will be forwarded to voice mail 144 for the subscriber.

With this amendment Applicant has cancelled claims 8-24 and amended claim 1 in order to better define the claimed invention in view of the prior art. The amendment to claim 1 is set forth in the specification as originally filed, and is in response to the Examiner's comments on page 6 of the September 23 office action.

These amendments distinguish the claimed invention over Griffith et al who teach that when a wireless terminal enters a new location, the telephone number assigned to the wireless terminal is automatically changed to be a telephone number assigned to that location. (see column 1, lines 54-58 of Griffith et al.)

In column 3, lines 18-27, Griffith et al teaches that upon being informed that wireless terminal 112 has entered location 104, wireless switching system 111 examines Table 2 of FIG. 3 for the telephone numbers assigned to location 104 at present, telephone number 538-1901 is assigned to wireless terminal 114. Hence, wireless switching system 111 assigns telephone number 538-1902 to wireless terminal 112. Table 1 of FIG. 2 is updated to reflect this change and the updated table is illustrated in FIG. 4. In addition, Table 2 of FIG. 3 would be updated to reflect the fact that wireless terminal 112 is now assigned telephone number 538-1902. If wireless terminal 114 had not been present in location 104 when wireless terminal 112 entered location 104, wireless terminal 112 would have been assigned telephone number 538-1901. Table 2 of FIG. 3 will also be updated to reflect the fact that telephone number 538-3901 is no longer assigned to wireless terminal 112.

Thus it is clear that Griffith et al. not only does not anticipate the present invention as set forth in the independent claims, but Griffith et al. actually teaches away from the present claimed invention. Griffith et al teaches automatically changing numbers assigned to mobile

stations, whereas in the present invention when the subscriber purchases the phone, the service provider permanently assigns the numbers to the phone of the subscriber, and the service provider defines one or more instances of user zone.

More specifically independent claim 1 of the present invention is now directed to a method having the steps of: assigning permanent first and second numbers to a mobile station; assigning permanent user zones to the mobile station; assigning temporary user zones to the mobile station; employing the first number when the mobile station is located in a first location in a respective permanent user zone of the permanent user zones, wherein the first number allows connection to the mobile station of a call that employs the first number; and employing the second number when the mobile station is located in a second location in a respective temporary zone of the temporary zones, wherein the second number allows connection to the mobile station of a call that employs the second number, wherein the second number differs from the first number, wherein the second location differs from the first location.

Since each of the dependent claims 2, 3, 5, and 7 include all the limitations of the respective independent claims, upon which they depend, these claims are also not anticipated by Griffith et al. These dependent claims are believed to be allowable for the same reasons as the related independent claims, as well as for their own additional characterizations.

Therefore, the rejection of claims 1-3, 5, and 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,195,558 to Griffith et al. has been overcome, and the Examiner is respectfully requested to reconsider this rejection.

Claim Rejections - 35 U.S.C. §103:

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 states:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

In the office action the Examiner made the following rejections.

Claim 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith et al. in view of Bansal et al. Regarding claims 4 and 11, Griffith et al. discloses a method as discussed supra in claims 1 and 8 above. Griffith et al. differs from claims 4 and 11 of the present invention in that it do not disclose the step of selecting a discounted billing

rate for the call that employs the second number. Bansal et al. teaches the step of selecting a discounted billing rate for the call that employs the second number (col. 5 lines 40-56 and col. 6 lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Griffith et al. with the step of selecting a discounted billing rate for the call that employs the second number in order to save money based upon a calling plan between the wireless terminal and its carrier, as taught by Bansal et al.

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith et al. in view of Chavez, Jr.. Regarding claims 6 and 13, Griffith et al. discloses a method as discussed supra in claims 1 and 8 above. Griffith et al. differs from claims 6 and 13 of the present invention in that it do not disclose the step of directing to voice mail, upon location of the mobile station at the second location, a call that employs the first number. Chavez, Jr. Teaches the step of directing to voice mail, upon location of the mobile station at the second location (wireless terminal leaves first location), a call that employs the first number (col. 5 lines 3450). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Griffith et al. with the step of directing to voice mail, upon location of the mobile station at the second location, a call that employs the first number in order for the wireless terminal to replay the first number message and decide whether to respond to the message, as taught by Chavez, Jr.

With regards to the dependent claims 4 and 6 rejected under 35 U.S.C. 103(a) and since each of the dependent claims include all the limitations of the respective independent claims, upon which they depend, these dependent claims are also not anticipated by Griffith et al. and any combination of the cited prior art. These dependent claims are believed to be allowable for the same reasons as independent claim 1, as well as for their own additional characterizations.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Therefore, the rejections of the claims under 35 U.S.C. § 102 and under 35 U.S.C. § 103 have been overcome, and the Examiner is respectfully requested to reconsider these rejections.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Carmen B. Patti", with a stylized flourish at the end.

Carmen B. Patti
Attorney for Applicants
Reg. No. 26,784

Dated: December 19, 2003

PATTI & BRILL, LLC
Customer Number 32205